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EXAMINER

MACNEILL, ELIZABETH

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3767

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10/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Election/Restrictions

1. Claims 7-11, 30-32,34, 39-41,44,54-58,66-68,70 and 73-75 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3 August 2006.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson (US 4,979,951).

2. Simpson teaches a catheter (Fig 3) having:

A first elongate tubular body (108) having a proximal portion (46, Fig 1A), a distal portion (at 101b, just before notch 102), and lumen extending between the proximal and distal end (Fig 4);

A second elongate tubular body (101a) having a proximal end (at 128, just after notch 102) and a distal end (see Fig 3 where guide wire 113 extends from the distal end) and a lumen (guide wire lumen 111);

An elongate member (101, only section with notch 102) joining the first and second tubular bodies;

Further comprising a third elongate member (106) having a proximal portion (cable 116) and a distal portion (cutting edge 157, Fig 7) and a lumen (tube 116 may be hollow, Col 6 line 66, " The cable 116 can be hollow or solid");

At least the proximal portion of the third elongate body being disposed within the lumen of the first body (Fig 2C) and being slidable so that the distal portion of the third body is within the second body (Fig 2D);

Wherein the proximal portion of the third body is maintained within the lumen of the first body by a mechanical stop (161, Fig 7)

As to claim 2, 38, see Fig 3; claims 4,5 Fig 5; claim 6, Fig 3; claim 12, Fig 5; Claim 13,14 Fig 3; claim 15, 16, 17, shaft 107; claim 29, balloon 127; claim 33, Fig 2C; claim 35, plastics are used at Col 2 line 48; claims 45-48, 50-53, 59-65, 69, 71 and 72, see Fig 2A-2E.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson

Simpson is silent on the specific dimensions of the catheter. Shanley's catheter is sized and shaped to be used in the human vasculature, and therefore must fall within certain anatomical limitations. It would have been well within the skill of one of ordinary skill in the art at the time the invention was made to use the dimensions claimed by the

applicant as a matter of optimization to allow the catheter to be used within the human vasculature.

Response to Arguments

Applicant's arguments with respect to claims 1-75 have been considered but are not persuasive. It is unclear why the applicant finds his amendments overcome the rejection when each of the claimed positions of the third elongate member is shown in Simpson Fig 2B-2E. Some explanation or argument of why the applicant believes these features are not shown is required beyond simply asserting that "Simpson does not disclose or teach a catheter having first, second and third elongate tubular bodies having the features required by claim 36" and other claims. The rejection is maintained.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH R. MACNEILL whose telephone number is (571)272-9970. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth R MacNeill/
Examiner, Art Unit 3767
/Kevin C. Sirmons/
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